

REMARKS

Claims 1-14 are pending in the present application. Claims 7-14 are added. No new matter has been added because of the newly added claims.

Support for New Claims

Support for newly added claims 7-13 is found in the specification as filed beginning on page 4 at line 1 extending through page 25, line 33. Support for newly added claim 14 is found in the specification as filed in Example 1 beginning on page 37 at line 27; and on page 41 at line 14.

The Miyata Declaration

The attention of the Examiner is invited to the document entitled "DECLARATION UNDER 37 CFR 1.132" signed on 10/23/2002 by the inventor, Hiroyuki Miyata (the Miyata Declaration). The factual showing in the Miyata Declaration clearly shows that the claimed subject matter has utility and fully meets the requirements of 35 U.S.C. § 101. The Miyata Declaration also clearly shows that the claimed subject matter fully meets the how-to-make requirements of the first paragraph of 35 U.S.C. § 112.

The Specification is Adequate to Support the Claimed Genus

Although rejections have been made under both 35 USC 101 and 35 USC 112, this case actually presents only a single issue. That single issue is: whether the application as filed teaches the skilled artisan how to produce something useful from the claimed compounds. It does for reasons which appear more fully below.

It is undisputed that at least one of the bicyclic compounds of formula I of claim 1 can be used to produce the methyl ester of 5-methyl-proline. This simple, monocyclic, compound of known utility is synthesized in the form of its trifluoroacetate salt as described in the specification as filed in the example beginning on page 41 at line 9.

The methyl ester of 5-methyl-proline is also used as a starting material in European Patent EP 0 618 926 B1", hereinafter referred to simply as EP '926. See EP '926, page 14, Line 44, wherein the methyl ester of 5-methyl-proline is indicated by the name "H-(R)Pro(5-(S)Me)-OMe". Accordingly, EP '926 teaches those skilled in the art how to use a methyl ester of 5-methyl-proline to produce other useful compounds. The attention of the Examiner is invited to Example 79 (EP '926, page 43, line 16) and to Example 80 (EP '926, page 43, line 37).

It is therefore undisputed that: (a) the specification as filed teaches the skilled artisan how to use some compounds of pending claim 1 to produce the methyl ester of 5-methyl-

proline; and (b) EP '926 teaches how to convert the methyl ester of 5-methyl-proline to useful compounds. The inescapable conclusion is that the application as filed teaches the skilled artisan how to produce something useful from the claimed compounds.

The sufficiency of the application as filed is even more evident when proper consideration is given to the Miyata Declaration. Example 1 of the Miyata Declaration produces a bicyclic compound of the present invention, the structure of which is shown on the first line of page 2 of the Miyata Declaration. This very bicyclic compound is then used in "Reference Example 1" on page 3 of the Miyata Declaration to produce the very same methyl ester of 5-methyl-proline which (a) is synthesized in the example beginning on page 41 line 9 of the application as filed as referred to above; and (b) which is undisputedly useful as described in EP '926 also as described above. It has thus been demonstrated that at least two compounds, within the scope of those claimed, are useful to produce a single useful compound i.e. the methyl ester of 5-methyl-proline.

The Miyata Declaration shows more. In the text referred to as an "Additional Example" on page 4, another compound is produced. This compound is then used as described on page 5 of the Miyata Declaration to produce methyl ester of 5-propyl-proline, another useful compound.

The Miyata Declaration shows still more. The attention of the examiner is respectfully invited to the reaction equation given on page 3 of the Miyata Declaration. The starting material is one within the scope of those claimed, as defined by formula I wherein R^1 is the disclosed biphenyl compound; R^2 is hydrogen; R^3 is methyl and R^4 is methyl. The resultant product is the often-mentioned methyl ester of 5-methyl-proline. It is relevant that the methoxy group, representing R^3 does not find its way into the final product. It is also relevant that the substituents on the nitrogen atom do not find their way into the final product. Because neither of these substituents find their way into the final useful product, a broad range of equivalents have been proven to be useful. They are useful because they do not participate.

The non-participatory nature of R^1 and R^3 is further shown by the equation on page 5 of the Miyata declaration. Again neither of these substituents finds its way into the final product.

Referring still to the Miyata Declaration, comparing the equation of page 3 with that of page 5, it can be seen that the species for R^4 does not participate in the reaction, but rather is carried along. The species for R^4 is CH_3 in the equation on page 3 and is C_3H_7 in the equation on page 5. The character of R^4 is unchanged by the reaction. This means that useful compounds are produced irrespective of the value for R^4 .

The conclusions are inescapable. The results of the Additional Reference Example, it is clear that the intermediate compounds of the present invention can be easily converted to the proline final products which are useful.

Thus the Miyata Declaration shows that the compounds of the present invention can be easily converted to final products. This is apparent to those skilled in the art even when there is no specific disclosure about the synthetic method of the final product other than Reference Example 1 on pages 41 and 42 of the application as filed.

The Specification is Adequate to Support Claim 14

Newly added independent claim 14 is directed to the undisputed novel species disclosed in the specification on page 37 at line 27 and on page 41 at line 14. The species of claim 14 produces the often-mentioned methyl ester of 5-methyl-proline, a compound disclosed in EP '926 as useful to produce certain final products. Irrespective of the Examiner's view of the adequacy of the disclosure with respect to the genus of claim 1, the species of independent claim 14 is useful and clearly disclosed to be so.

A First Action Final Rejection Would be Premature

A good faith effort has been made by the undersigned to advance prosecution of this case. This good faith effort

includes the addition of new claims, which present issues different than those currently pending. It is respectfully submitted that the factual showing made in the Miyata Declaration overcomes all grounds of rejection. However, should the Examiner take a contrary view, the undersigned reserves the right to make additional factual showings under the provisions of 37 C.F.R. § 1.132 or otherwise. The premature issuance of a final rejection might inhibit the submission of such a showing. For these reasons, a first action final rejection would be premature.

Summary

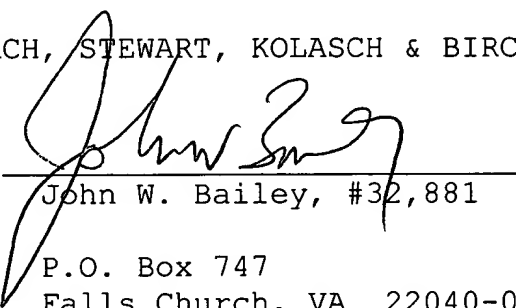
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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